UNITED STATES PATENT AND TRADEMARK OFFICE

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09/772,541	01/29/2001	Robert M. Caruso	6909-5	9250

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EXAMINER
JEAN GILLES, JUDE

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/772,541	CARUSO ET AL.
	Examiner	Art Unit	
	Jude J. Jean-Gilles	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>09 December 2005</u>.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-50* is/are pending in the application.

   4a) Of the above claim(s) *45,49 and 50* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-44 and 46-48* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *29 January 2001* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some *   c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

This Action is in regards to the Reply received on 12/09/2005.

Response to Amendment

1.   This action is responsive to the application filed on 12/09/2005.

Responsive to the restriction requirement set forth by the Examiner in a telephone

conversation on August 29, 2005, with Ariel Rogson, the Applicant confirms

election of claims 1-48 for prosecution and withdrawal of claims 49-50 without traverse.

The Applicant reserves the right to file a divisional application on non-elected claims 49-

50.

Claims 1-50 are pending. Claims 1-7, 9-l0, 12 and 42-47 stand rejected under 35

U.S.C. 102(e) as being anticipated by U.S. Patent. No. 6,721.784 B1 to Leonard.

Claims 8, 11, 13-41 and 48 stand rejected under 35 U.S.C. I 03(a) as being

unpatentable over Leonard in view of U.S. Pat. No. 6,078,921 to Kelley. Claims 49-50

stand withdrawn as directed xo a non-elected invention.   Claims 8, I 4, 18, 41, 42

and46 have been amended. Claims 45, 49 and 50 are canceled. Claims 1-44 and 46-48

remain in the case for consideration and represent methods for "rich media file format

and delivery".

Response to Arguments

2.   Applicant's arguments with respect to claims 1, 12, 42, and 46 have been

carefully considered, but are not deemed fully persuasive. Applicant's arguments are

deemed moot in view of the existing ground of rejection as explained here below.

The dependent claims stand rejected as articulated in the First Office Action and

all objections not addressed in Applicant's response are herein reiterated.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-7, 9-10, 12, and 42-47** are rejected under 35 U.S.C. 102(e) as being

anticipated by Leonard et al. (Leonard), Patent No. 6,721,784 B1.

Regarding **claim 1**, Leonard discloses a rich media file stored in a machine-readable

medium (fig. 6, item 2), comprising:

information to be displayed on a computer system (column 18, lines 51-67; column 19,

lines 1-15); and

a viewer desired to display the information on the computer system,

the information and the viewer contained in a single file (column 9, lines 23-30; column 14,lines 40-67).

Regarding **claim 2**, Leonard discloses a rich media file according to claim 1,further comprising limit means for limiting viewing of the rich media file (column 14, lines 40-67; column 15; lines 1-61).

Regarding **claim 3**, Leonard discloses a rich media file according to claim 2, wherein the limit means is selected from a setting defining a predetermined number of viewings of the information, a setting defining a predetermined number of days, a predetermined expiration date, and a password controlling access to the rich media file (column 16, lines 12-26; column 17, lines 32-56).

Regarding **claim 4**, Leonard discloses a rich media file according to claim 2, wherein limit means is designed to expire the rich media tile, and rich media file is designed so that it cannot be viewed after the rich media file has expired (column 16, lines 12-26; column 17, lines 32-56).

Regarding **claim 5**, Leonard discloses a rich media file according to claim 1, further comprising checking means for checking if there is a later version of the rich media file (column 13, lines 32-55; column 12, lines 51-67).

Regarding **claim 6**, Leonard discloses a rich media file according to claim 1, further comprising a query asking a user if the user would like to retrieve a later version of the rich media file (column 13, lines 32-55; column 12, lines 51-67).

Regarding **claim 7**, Leonard discloses a rich media file according to claim 1, further

comprising retrieval means for retrieving a later version of the rich media file (column

13, lines 32-55; column 12, lines 51-67).

Regarding **claim 9**, Leonard discloses a rich media file according to claim 1, the rich

media file further comprising a unique file identification in addition to a file name

(column 10, lines 56-67).

Regarding **claim 10**, Leonard discloses a rich media file according to claim 1, wherein

the information is formatted into a plurality of pages (column 16, lines 27-54).

Regarding **claim 12**, Leonard discloses a rich media file according to claim 1, wherein

the viewer includes only a capability desired by a builder of the rich media file

(column14, lines 41-67).

Regarding **claim 42**, Leonard discloses a memory for storing a platform-independent

rich media file including a data structure stored in said memory, comprising:

information for the rich media file (column 18, lines 51-67; column 19, lines 1-15);

a unique identification for the rich media file (column 10, lines 56-67);

a version number for the rich media tile (column 13, lines 32-55; column 12, lines 51-

67); and

at least one viewing option for the rich media file (column 9, lines 23-30; column 14,lines

40-67).

Regarding **claim 43**, Leonard discloses a memory according to claim 42, wherein the

data structure further includes a client identification for a client creating the rich media

file (column 10, lines 56-67).

Regarding **claim 44**, Leonard discloses a memory according to claim 42, wherein the

data structure further includes expiration features (column 16, lines 12-26; column 17,

lines 32-56).

Regarding **claim 45**, Leonard discloses a memory according to claim 42, wherein the

data structure further includes a viewer for displaying the information (column 9, lines

23-30; column 14,lines 40-67).

Regarding **claim 46**, Leonard discloses a memory for storing a database of rich media

files including a data structure stored in said memory, comprising:

a rich media file (column 18, lines 51-67; column 19, lines 1-15);

a profile of a user who downloaded the lich media file (column 12, lines 50-67);

a client who generated the rich media file (column 14, lines 1-67); and

a log storing a transaction in the data structure (column 12, lines 50-67).

Regarding **claim 47**, Leonard discloses a memory according to claim 46, the data

structure further including a mapping from the rich media file to the client (column 14,

lines 40-67).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

6. **Claims 8, 11, 13-41, and 48** are rejected under 35 U.S.C. 103(a) as being

unpatentable over Leonard in view of Kelley (Kelly), U.S. Patent No: 6,078,921.

Regarding claim 8, Leonard teaches the invention substantially as claimed. Leonard

teaches the rich text file of claim 1, but does not specifically teach a rich media file

wherein the information is compressed using a compression technique to reduce the

size of the rich media file.

In the same field of endeavor, Kelly discloses "…a combined single file referred to as a

result field that can be compressed or uncompressed..[see Kelly, column 6, lines 39-

62].

Accordingly, it would have been obvious to one of ordinary skill in the networking

art at the time the invention was made to have incorporated Kelly's teachings of a

technique to compressed a rich text field, with the teachings of Leonard, for the

purpose of "*allowing control of viewing and handling of the electronic field*

message and allowing the user to view the message using the applet viewer…"

as stated by Leonard in lines 51-55 of column 14. By this rationale **claim 8** is

rejected.

The same motivation used for claim 8 is also valid for **claims 11, 13-41, and 48**

below [see Leonard, column 51-55, lines 14].

Regarding **claim 11**, the combination of Leonard-Kelly discloses a rich media file

according to claim 10, wherein the information includes a link from a first page of

the information to a second page of the information [see Kelly, column 8, lines

24-64].

Regarding claim 13, the combination of Leonard-Kelly discloses a rich media file

stored in a machine-readable medium, comprising:

information to be displayed on a computer system, the information compressed using

a compression technique [see Kelly; column 6, lines 39-62];

a viewer designed to display the information on the computer system [see Leonard;

column 9, lines 23-30; column 14,lines 40-67];

limit means for limiting viewing of the rich media file, the limit means drawn from a

setting defining a predetermined number of viewings of the information, a setting

defining a predetermined number of days, a predetermined expiration date, and a

password controlling access to the rich media file [see Leonard; column 16, lines 12-26;

column 17, lines 32-56];

checking means for checking if there is a later version of the rich media file [see

Leonard; column 13, lines 32-55; column 12, lines 51-67];

a query asking a user if the user would like to retrieve the later version of the rich

media file [see Leonard;];

retrieval means for retrieving the later version of the rich media file [see Leonard;]; and

a unique file identification for the lich media file in addition to a file name [see Leonard;

column 13, lines 32-55; column 12, lines 51-67].

Regarding **claim 14**, the combination of Leonard-Kelly discloses a method for retrieving

a lich media file, the method comprising:

selecting a link on a network [see Kelly; column 6, lines 23-63];

downloading the rich media tile over the network based on a unique file identification

other than the link and other than a tile name [see Leonard; column 10, lines 56-67];

and

saving the rich media file on a computer system [see Leonard; column 18, lines 51-67}.

Regarding **claim 15**, the combination of Leonard-Kelly discloses a method according to

claim 14, wherein selecting a link includes transmitting the unique file identification over

the network [see Leonard; column 10, lines 56-67].

Regarding **claim 16**, the combination of Leonard-Kelly discloses a method according to

claim 14, wherein downloading the rich media file over the network from a remote

server includes downloading the rich media file over the network from a remote server

different from a second server that includes the link [see Kelly; fig. 1, item 126; column

6, lines 24-62].

Regarding **claim 17**, the combination of Leonard-Kelly discloses a method according to

claim 14, wherein downloading the rich media file includes downloading an earlier

version of the rich media file [see Kelly; fig. 1, item 126; column 6, lines 24-62]..

Regarding **claim 18**, the combination of Leonard-Kelly discloses a method according to

claim 14, the method further comprising opening the rich media file using a viewer built

into the rich media file [see Leonard; column 13, lines 32-55; column 12, lines 51-67].

Regarding **claim 19**, the combination of Leonard-Kelly discloses a method according to

claim 18, wherein opening the rich media file includes checking to see if a later version

of the rich media file is available over the network [see Leonard; column 13, lines 32-55;

column 12, lines 51-67].

Regarding **claim 20**, the combination of Leonard-Kelly discloses a method according to

claim 19, wherein checking to see if a later version of the rich media file is available

includes;

asking a user whether the later version of the rich media file is desired; and

if the user requests the later version of the rich media file [see Leonard; column 13,

lines 32-55; column 12, lines 51-67];

downloading the later version rich media file [see Leonard; column 13, lines 32-55;

column 12, lines 51-67]; and

opening the later version of the rich media file using a viewer built into the

later version of the rich media file[see Leonard; column 13, lines 32-55; column 12, lines

51-67].

Regarding **claim 21**, the combination of Leonard-Kelly discloses a method according to

claim 18, wherein opening the rich media file includes:

checking to see if the lich media file has expired [see Leonard; column 16, lines 12-26;

column 17, lines 32-56]; and

if the rich media file has expired, asking the user if a later version of the rich media

file or chained file is desired [see Leonard; column 16, lines 12-26; column 17, lines 32-

56].

Regarding **claim 22**, the combination of Leonard-Kelly discloses a method according to

claim 21, wherein checking to see if the rich media file has expired includes refusing to

open the lich media file if the rich media file has expired [see Leonard; column 16, lines

12-26; column 17, lines 32-56].

Regarding **claim 23**, the combination of Leonard-Kelly discloses a method according to claim 18, wherein opening the rich media file includes:

prompting for a password; and refusing to open the rich media file if the password is not provided [see Leonard; column 16, lines 12-43].

Regarding **claim 24**, the combination of Leonard-Kelly discloses a method according to claim 14, the method further comprising deleting the rich media file, thereby leaving no footprint on the computer system [see Leonard, column 18, lines 34-65; see Kelly, column 7, lines 16-30].

Regarding **claim 25**, the combination of Leonard-Kelly discloses a computer-readable medium containing a program to retrieve a rich media file, the program being executable on computer system to implement the method of claim 14 [see Leonard; column 13, lines 32-55; column 12, lines 51-67];

Regarding **claim 26**, the combination of Leonard-Kelly discloses a method for building a unitary lich media file, the method comprising:

assembling information for the unitary rich media file [see Leonard; column 17, lines 18-56];

formatting the information [see Leonard; column 17, lines 18-56];

coupling the information with a viewer [see Leonard; column 9, lines 23-30; column 14,lines 40-67]; and

converting the information and the viewer to the unitary rich media file [see Leonard; column 9, lines 23-30; column 14,lines 40-67], so that the unitary rich media file is

designed to leave no footprint on a user's system when removed [see Kelly, column 7, lines 16-30].

Regarding **claim 27**, the combination of Leonard-Kelly discloses a method according to claim 26, wherein formatting the information includes placing the information on a plurality of pages [see Leonard; column 16, lines 27-54].

Regarding **claim 28**, the combination of Leonard-Kelly discloses a method according to claim 27, wherein formatting the information further includes placing a link on a first page of the information to a second page of the information [see Kelly, column 8, lines 24-64].

Regarding **claim 29**, the combination of Leonard-Kelly discloses a method according to claim 26, wherein formatting the information includes selecting viewing options to include with the rich media file [see Leonard; column14, lines 41-67].

Regarding **claim 30**, the combination of Leonard-Kelly discloses a method according to claim 26, wherein formatting the information includes assigning expiration parameters to the rich media file [see Leonard; column 16, lines 12-26; column 17, lines 32-56].

Regarding **claim 31**, the combination of Leonard-Kelly discloses a method according to claim 26, wherein formatting the information includes placing the information into a platform-independent intermediary state [see Kelly; column 16, lines 12-54; column 18, lines 34-65].

Regarding **claim 32**, the combination of Leonard-Kelly discloses a method according to claim 26, wherein coupling the information with a viewer includes coupling the

information with the viewer for a particular computer platform [see Kelly; column 16,

lines 12-54; column 18, lines 34-65].

Regarding **claim 33**, the combination of Leonard-Kelly discloses a method according to

claim 26, wherein converting the information includes formatting the information from an

intermediate file format to a format for display in the rich media file, the format for

display designed to work with the viewer on a particular platform [see Kelly; column 16,

lines 12-54; column 18, lines 34-65].

Regarding **claim 34**, the combination of Leonard-Kelly discloses a method according to

claim 26, wherein converting the information includes compressing an image in the

information [see Leonard; column 9, lines 23-30; column 14,lines 40-67];

Regarding **claim 35**, the combination of Leonard-Kelly discloses a method according to

claim 26, wherein converting the information includes converting the information to the

rich media file at a server not owned by a client building the rich media file [see Kelly;

fig. 1, item 126; column 6, lines 24-62].

Regarding **claim 36**, the combination of Leonard-Kelly discloses a method according to

claim 26, the method further comprising:

storing the rich media file on a server [see Kelly; fig. 1, item 126; column 6, lines 24-

62]; and

placing a link to the rich media file on a web page over a computer network [see

Leonard; column 6, lines 43-60].

Regarding **claim 37**, the combination of Leonard-Kelly discloses a method according to

claim 36, wherein storing the rich media file includes assigning the rich media file a

unique file identification in addition to a file name [see Leonard; column 10, lines 56-67].

Regarding **claim 38**, the combination of Leonard-Kelly discloses a method according to

claim 37, wherein placing a link includes using the unique file identification in the link

[see Kelly, column 8, lines 24-64].

Regarding **claim 39**, the combination of Leonard-Kelly discloses a method according to

claim 36, wherein storing the rich media file includes storing the rich media file on a

server different from the one storing the link [see Kelly; fig. 1, item 126; column 6, lines

24-62].

Regarding **claim 40**, the combination of Leonard-Kelly discloses a method according to

claim 36, wherein storing the rich media file includes retaining an earlier version of the

rich media file on the server [see Kelly; fig. 1, item 126; column 6, lines 24-62].

Regarding **claim 41**, the combination of Leonard-Kelly discloses a computer-readable

medium·containing a program to retrieving a lich media file, the program being

executable on a computer system to implement the method of claim 26 [see Leonard;

column 13, lines 32-55; column 12, lines 51-67].

Regarding **claim 48**, the combination of Leonard-Kelly discloses a memory according to

claim 46, the data structure further including an auto-notification for the user when the

rich media file is updated [see Kelly; column 8, lines 24-67; column 9, lines 1-7].

Response to Arguments

7.   Applicant's Request for Reconsideration filed on 12/09/2005 has been carefully

considered but is not deemed fully persuasive. However, because there exists the

likelihood of future presentation of this argument, the Examiner thinks that it is prudent

to address Applicants' main points of contention.

> A. The Lee patent fails to disclose or suggest, and is not all related to, Leonard
>
> teaches integrating the origination software with the viewer 18, lines 53-55
>
> saying, the viewer and origination software are combined into a single program."
>
> Although Leonard teaches: software with an origination component and a viewing
>
> component integrated together. Leonard does not teach a viewer applet that
>
> includes the message itself. Indeed column 14, lines 51-55 describes retaining
>
> the message on the electronic mail server aad requiring the recipient to view the
>
> message using the viewer applet. Later in column 14, lines 60-63, Leonard says
>
> that the viewer applet retains only applet in column transient storage of the
>
> message.
>
> B. Applicant contends that Leonard does not teach building a message that
>
> includes only controls that are intended by the originator of the message. By
>
> teaching a system where control features that are to be included in the message
>
> resides in a header for the message, Leonard does not teach building a rich
>
> media file, where some components are included or excluded based on the intent
>
> of the creator.

C. Applicant contends that claim 13 includes a unique file identification foe the. rich media file in addition to a file name, and claim 14 downloads a file based on a unique file identification other than the link and other that a file name. While Leonard might suggest a unique file single unique file identification by teaching message attributes including in a header, and Leonard does not provide a single unique file identification for a rich media fiel, that guaranties a unique identifier other that a file name.

D. Applicant contends that neither Kelly nor Leonard teach a unique file identification in addition to a file name, particularly a unique identification that is used in downloading a file over the network are not suggested by Leonard and Kelly.

8.   As to "Point A" it is the position of the Examiner that Leonard in detail teaches the limitations of the above mentioned claims. In page 10 of the response, applicants rightfully admits "Leonard teaches: software with an origination component and a viewing component integrated together". [see Leonard; column 21, lines 53-59; fig. 8, item 2]. This is a clear anticipation of the invention and the rejection under rejected under 35 U.S.C. 102(e) is maintained. Also, see rejection of claim 1 above.

As to "Point B" it is also the position of the examiner that "building a message that includes only controls that are intended by the originator of the message" is taught by Leonard [see Leonard; column 23, lines 55-61].

As to "Point C", see rejection of claim 13 above.

As to Point D, see rejection of claims 13, and 14 above.

Conclusion

9.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

10.   Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-9000.

Jude Jean-Gilles

Patent Examiner

Art Unit 2143

JJG

February 15, 2006

DAVID WILEY
SUPERVISORY PATENT EXAMINER
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